

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 60119-0011						
<p>Pursuant to 37 CFR 1.8(a)(1)(ii) I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office via the electronic filing system in accordance with 37 CFR §§1.6(1)(4) and 1.8(a)(1)(i)(C) on the date indicated below and before 9:00 PM PST.</p> <p>on <u>1/31/08</u></p> <p>Signature <u>/JuliaAThomas#52283/</u></p> <p>Typed or printed name <u>Julia A. Thomas</u></p>	<table border="1" style="width: 100%; border-collapse: collapse;"><tr><td style="width: 50%; padding: 5px;">Application Number 10/017,858</td><td style="width: 50%; padding: 5px;">Filed December 14, 2001</td></tr><tr><td colspan="2" style="padding: 5px;">First Named Inventor Stephen SCHLEICHER</td></tr><tr><td style="padding: 5px;">Art Unit 3693</td><td style="padding: 5px;">Examiner Apple, Kirsten</td></tr></table>		Application Number 10/017,858	Filed December 14, 2001	First Named Inventor Stephen SCHLEICHER		Art Unit 3693	Examiner Apple, Kirsten
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First Named Inventor Stephen SCHLEICHER								
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<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p>          <p>This request is being filed with a notice of appeal.</p>          <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>          <p>I am the</p> <table style="width: 100%;"><tr><td style="width: 50%; vertical-align: top;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>52,283</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></td><td style="width: 50%; vertical-align: top; padding-left: 20px;"><p><u>/JuliaAThomas#52283/</u> Signature</p><p><u>Julia A. Thomas</u> Typed or printed name</p><p><u>(408) 754-1451</u> Telephone number</p><p><u>January 31, 2008</u> Date</p></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			<p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>52,283</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>	<p><u>/JuliaAThomas#52283/</u> Signature</p> <p><u>Julia A. Thomas</u> Typed or printed name</p> <p><u>(408) 754-1451</u> Telephone number</p> <p><u>January 31, 2008</u> Date</p>				
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☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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**ATTACHMENT TO FORM PTO/SB/33**  
**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The Final Office Action rejected Claims 1 and 12 under 35 U.S.C. §102(e) as allegedly anticipated by Ewald. As discussed below, all the rejections of all pending claims are based on clear errors of fact. Therefore, the Office should reverse the rejections.

Claims 1 and 12 recite, among other features: “based on the corresponding agreement, transforming the processed document from the standard format into an altered document format that is associated with a second partner and sending the altered document to the second partner.” At page 3, the Final Office Action contends that “Mapping document into altered format and sending to second partner based on agreement (see Ewald, Paragraph 15, ‘independent of content and format’ – it is inherent it would need to map as necessary different formats to make it ‘independent’) ...” The Office Action is incorrect because it ignores claim language. In particular, the Final Office Action fails to identify any part of Ewald that corresponds to an altered document format “that is associated with a second partner.”

On this basis alone, the rejections of Claims 1 and 12 are predicated upon clear error of fact. Because the Final Office Action does not establish that every feature of the claims is found in the cited references, the Office Action fails to establish a *prima facie* case of unpatentability for anticipation.

Further, nothing in Ewald paragraph 15 can support the Final Office Action’s position. Ewald paragraph 15 recites: “It is a further object of this invention to provide such a document exchange system which is independent of content and format and thus more universal to design.” Paragraph 15 is unrelated to “transforming the processed document from the standard format into an altered document format that is associated with a second partner,” as expressly recited in Claims 1 and 12. Indeed, Paragraph 15 expressly recites “independent of ... format,” which is

contrary to the claimed feature. Ewald Paragraph 15 **teaches away** from the claimed approach by suggesting a system that uses **a single document format, without transforming the format of the document**. For this additional reason, the rejection is based upon clear error.

At page 6, second paragraph, the Final Office Action further contends, in responding to Applicants' prior arguments, that "... it is important to point out 'searches for documents in any format' paragraph 0042, line 7-8. Which makes it clear that not all of the users are using the same format." The contention is immaterial, because the cited part of Ewald fails to show or imply "transforming the processed document from the standard format into an altered document format that is associated with a second partner," as expressly recited in Claims 1 and 12. The system of Ewald is structured to communicate information for documents in multiple different formats **without transforming the format of the document**, as claimed.

On page 6, third paragraph, the Final Office Action further states, "... it is important to point out 'extract from all retrieved capsules' and 'forward to second party interface program' (paragraph 0041)." However, the quotation in the Final Office Action omits significant language of Ewald paragraph 0041, which states: "Finally, capsule extractor 64 is configured to extract from all the retrieved capsules the original posted documents which are then forwarded to second party interface program 53." The Final Office Action erroneously omits Ewald's reference to working with "the original posted documents." Clearly, if Ewald's system is communicating "the original posted documents" to a second party, Ewald is not involved in transforming the format of the original posted documents. Ewald proposes an approach for dealing with different document formats that is completely different from the claimed approach because there is no transformation. The use of "capsules" in Ewald means that transformation of format is unnecessary.

For all these reasons, the Final Office Action is based upon a clear error. Therefore, the rejection of Claims 1 and 12 under 35 U.S.C. §102(e) should be reversed.

By virtue of dependence from Claims 1 and 12, respectively, each of Claims 2-11 and 13-22 recites the features described above that distinguish claims 1 and 12 from Ewald. Therefore, the rejections of claims 2-11 and claims 13-22 should be reversed for the same reasons given above for claims 1 and 12.

Claims 23-56 also recite, directly or indirectly by dependence, the features described above that distinguish claims 1 and 12 from Ewald. Therefore, the rejections of claims 23-56 should be reversed for the same reasons given above for claims 1 and 12.

Applicants respectfully request reconsideration and reversal of the rejection of Claims 1-56 under 35 U.S.C. §102(e) for the reasons set forth above.